

PATENT APPLICATION

Attorney Docket: 54391

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS

Applicant: Ward
Serial No.: 9/655,987
Filed: 9/6/2000
For: Composition for Protecting Work Surfaces from
Contamination
Group Art Unit: 1774
Examiner: Dicus, Tamra

SUPPLEMENTAL BRIEF FOR APPELLANT

Hon. Commissioner of Patents
and Trademarks
Washington, D.C. 20231

Sir:

This is an appeal from the decision of the Primary Examiner dated 5/31/2005, rejecting Claims 1-8 and 19-28 in the above-identified patent application. Applicant originally filed an appeal after a final rejection dated 6/2/03. This first appeal was terminated by the Examiner because the Examiner wished to make new grounds for rejection. In addition to the new art rejection, the Examiner made a Section 112, second paragraph rejection that the Examiner could have made in the office action that preceded the first appeal. Because of this untimely new rejection, Applicant was forced to abandon the first appeal to correct this Section 112 issue. Were it not for that late Section 112 rejection, Applicant would have re-instated the original appeal, thereby saving the fees in question. Applicant filed a second appeal on 8/5/04 appealing the new grounds for rejection. The Examiner pointed out an error in the brief in question, and Applicant filed a corrected brief on 10/14/04. The Examiner then rejected the corrected brief because the Examiner maintained that the previously filed brief was defective because the summary of the invention did not contain a concise statement explanation of the subject matter of

each independent claim on appeal and because the grouping of the claims lacked a statement that each group of claims "stand or fall together". Applicant filed another brief pointing out that the Examiner was in error with respect to the "stand or fall together rejection" and that the Summary of the Invention had not changed since the original brief had been filed and that it met the requirements as proved by insertions indicating which independent claims were discussed at each point in the Summary.

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I. REAL PARTY IN INTEREST

The real party in interest is Calvin B. Ward.

II. RELATED APPEALS AND INTERFERENCES

There is an appeal in divisional application 10/278,190 presently pending that might directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. STATUS OF THE CLAIMS

Claims 1-8 and 19-28 are currently pending in the above-identified patent application. In the Office Action dated 5/31/2005, the Examiner reopened prosecution and rejected these claims.

IV. STATUS OF AMENDMENTS

No amendments have been entered after the rejection discussed above,

V. SUMMARY OF THE INVENTION

The present invention is directed to using a novel sheet to protect a surface by placing this sheet in contact with the surface. Refer to Figure 1 and the discussion thereof that begins at line 4 of page 3 of the specification. With reference to Claims 1 and 19, sheet 10 is constructed from an electrostatically charged sheet 11 having a top and bottom surface and an absorbent layer 12. The absorbent layer has top and bottom surfaces, the bottom surface of the absorbent layer being bonded to the top surface of the electrostatically charged sheet. With reference to Claim 19, the absorbent layer is divided into a plurality of cells 14 for containing liquid spilled on the absorbent layer. The absorbent layer can be constructed from paper, open cell foam, a fibrous mat, or any other absorbent material. In one preferred embodiment, the cells are constructed by providing hydrophobic barriers 13 in the absorbent layer. The barriers can be constructed from paraffin, plastic, or any other material that can penetrate the absorbent layer. Referring to Figure 2, and the discussion thereof that begins at page 4, line 18, a hydrophobic layer 21 is bonded to the top surface of the absorbent layer. The hydrophobic layer has a plurality of pores 22 that allow liquid spilled on the hydrophobic layer to penetrate the hydrophobic layer and be absorbed by the absorbent layer.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

A. Rejection of Claims 19-20 under 35 U.S.C. 102(b) as being anticipated by Schelhorn, *et al* (hereafter "Schelhorn") (US 3,342,613)

B. Rejection of Claims 1-3, 7-8, 19-21, and 25-28 under 35 U.S.C. 103(a) as being unpatentable over US 5,151,091 to Glaug, *et al* (hereafter "Glaug") in view of US 5,486,411 to Hassenboehler Jr., *et al* (hereafter "Hassenboehler").

C. Rejection of Claims 5 and 23 under 35 U.S.C. 103(a) as being unpatentable over Glaug in view of Hassenboehler and further in view of US 6,261,679 to Chen, *et al* (hereafter "Chen").

D. Rejection of Claims 4 and 22 under 35 U.S.C. 103(a) as being unpatentable over Glaug in view of Hassenboehler and further in view of US 5,807,366 to Milani.

E. Rejection of Claims 6 and 24 under 35 U.S.C. 103(a) as being unpatentable over Glaug in view of Hassenboehler and further in view of Chen and further in view of Milani.

VII. ARGUMENT

A. Examiner's Burden under 35 U.S.C. 102 and 103

Under 34 U.S.C. 102, the Examiner has the burden of showing by reference to the cited art each claim limitation in the reference. Anticipation under 35 U.S.C. 102 requires that each element of the claim in issue be found either expressly or inherently in a single prior art reference. *In re King*, 231 USPQ 136, 138 (Fed. Cir. 1986); *Kalman v. Kimberly-Clark Corp.*, 218 USPQ 781, 789 (Fed. Cir. 1983). The mere fact that a certain thing may result from a given set of circumstances is not sufficient to sustain a rejection for anticipation. *Ex parte Skinner*, 2 USPQ2d 1788, 1789 (BdPatApp&Int 1986). "When the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference" (*In re Rijckaert*, 28 USPQ2d, 1955, 1957). Under the doctrine of inherency, if an element is not expressly disclosed in a prior art reference, the reference will still be deemed to anticipate a subsequent claim if the missing element "is necessarily present in the thing described in the reference." *Cont'l Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). "Inherent anticipation requires that the missing descriptive material is 'necessarily present,' not merely probably or possibly present, in the prior art." *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295, 63 USPQ2d 1597, 1599 (Fed. Cir. 2002) (quoting *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)).

To sustain a rejection under 35 U.S.C. 103, the Examiner must show that the combined references teach each of the elements of the claim or that there is some motivation in the art for altering one of the teachings to arrive at the combined set of teachings. "The mere fact that a reference could be modified to produce the patented invention would not make the modification obvious unless it is suggested by the prior art." (*Libbey-Owens-Ford v. BOC Group*, 4 USPQ 2d 1097, 1103). "When the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference" (*In re*

Rijckaert, 28 USPQ2d, 1955, 1957). In addition, the Examiner must show that there is some motivation in the art that would cause someone of ordinary skill to combine the references, and that in making the combination, there was a reasonable expectation of success. Where the claimed subject matter has been rejected as obvious in view of a combination of prior art references, a proper analysis under section 103 requires, *inter alia*, consideration of two factors: (1) whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed composition or device, or carry out the claimed process; and (2) whether the prior art would also have revealed that in so making or carrying out, those of ordinary skill would have a reasonable expectation of success. Both the suggestion and the reasonable expectation of success must be founded in the prior art, not in the applicant's disclosure. *In re Vaeck*, 20 USPQ2d 1438, 1442(CAFC 1991).

B. Rejection of Claims 19-20 under 35 U.S.C. 102(b) as being anticipated by Schelhorn

In making this rejection, the Examiner looks to Figure 2 of Schelhorn, and specifically to element 10 as the water-impermeable electrostatically charged sheet required by Claim 19. However the Examiner has not pointed to any teaching that sheet 10 is electrostatically charged. Schelhorn teaches that the sheet is electrostatically treated or flame treated to improve the adhesive bonding characteristics of that surface (col. 2, lines 21-29), i.e., to cause the adhesive 14 to stick to the plastic sheet. Such treatments expose the surface of the sheet to a plasma that etches the surface. There is no teaching that the plastic sheet is left with an electrostatic charge after such treatment, no less that the electrostatic charge remains after it is placed in contact with the absorbent layer. It should be noted that plastic sheets can be temporarily charged by a number of methods; however, the charge rapidly dissipates on contact with the air or other materials. Further, such corona treatments are used commercially to remove static charge from sheets of plastic. Hence, merely subjecting plastic to an electrostatic treatment does not necessarily lead to an electrostatically charged sheet that has a charge that remains on the sheet at the end of the treatment. Accordingly, Schelhorn does not anticipate the present invention as claimed in Claim 19 either explicitly or inherently.

C. Rejection of Claims 1-3, 7-8, 19-21, and 25-28 under 35 U.S.C. 103(a) as being unpatentable over US 5,151,091 to Glaug in view of US 5,486,411 to Hassenboehler

With reference to Claims 1 and 19, the Examiner points to element 190 shown in Figure 2 of Glaug as the water-impermeable sheet and to the "canals" as the absorbent sheet that is divided into a plurality of cells. The Examiner admits that Glaug does not teach that sheet 190 is electrostatically charged. The Examiner looks to Hassenboehler as teaching that a polyethylene film can be electrostatically treated to improve filtration. The Examiner maintains that it would be obvious to apply the teachings of Hassenboehler to sheet 190 to improve filtration.

First, Applicant must point out that Hassenboehler teaches electrostatically charging a porous film to provide improved filtration of a medium passing through the film. A porous film is not water-impermeable. Sheet 190 taught in Glaug must be water impermeable to provide the desired barrier function. Furthermore, it does not provide any filtration function. Hence, one would not be led to apply the teachings of Hassenboehler to the article in Glaug because the article would either fail at its intended purpose, i.e., leak through the pores, or because there is no filtration function to improve with respect to sheet 190, and hence, there is no motivation to apply the teachings. Accordingly, Applicant submits that the Examiner has not made a *prima facie* case for obviousness with respect to Claims 1 and 19 or the claims dependent therefrom.

Second, the canals taught in Glaug are open ended. Hence, while the barriers prevent liquid from moving from one canal to another along the length of the canal, the barriers do not contain the liquid within the boundaries of the cells, since the ends of the cells are open. In fact, in the embodiments taught in Glaug, the boundaries allow liquid to flow between chambers when one chamber becomes full. Hence, there are additional grounds for allowing Claim 1.

With respect to Claims 2 and 20, the Examiner maintains that Glaug teaches the absorbent layer comprises paper or polymeric foam. The Examiner points to the passage at (col. 2, lines 60-65 – col. 3, line 5) as supporting this contention. The passage from col. 2, line 60 to col. 3, line 2 refers to the barriers as comprising the polymeric foam. Glaug also teaches that

barriers can be constructed from water proof paper. The remainder of the cited passage refers to the absorbent layer being chosen from a list of materials that does not include paper. Hence, there are additional grounds for allowing Claims 2 and 20.

With respect to Claims 3 and 21, the Examiner looks to the passage of Glaug at col. 4, lines 14-15 as teaching that the absorbent layer comprises an open cell foam, Applicant must disagree with the Examiner's reading of the passage in question. The passage refers to material for constructing the barriers, not the absorbent layer. Hence, there are additional grounds for allowing Claims 3 and 21.

D. Rejection of Claims 5 and 23 under 35 U.S.C. 103(a) as being unpatentable over Glaug in view of Hassenboehler and further in view of Chen

In making this rejection, the Examiner looks to the combination of Glaug and Hassenboehler as teaching the limitations of Claims 1 and 19. The Examiner admits that these references do not teach an absorbent material comprising a fibrous mat. The Examiner looks to Chen as teaching a fibrous mat.

Applicant repeats the arguments made above with respect to the missing teachings of the Glaug and Hassenboehler as applied to Claims 1 and 19. Chen does not provide the missing teachings. Accordingly, Applicant submits that the Examiner has not made a *prima facie* case for obviousness with respect Claims 5 and 23.

E. Rejection of Claims 4 and 22 under 35 U.S.C. 103(a) as being unpatentable over Glaug in view of Hassenboehler and further in view Milani

The Examiner looks to Glaug and Hassenboehler as teaching the elements of Claims 1 and 19. The Examiner admits that the combined references do not teach an absorbent layer that is an electrostatically charged open cell foam. The Examiner looks to Milani as providing the missing teaching. The Examiner maintains that it would be obvious to combine the teachings of Milani with the other references because Milani teaches that the charging provides improved liquid distribution.

First, Applicant repeats the arguments made above with respect to the lack of teachings of Glaug and Hassenboehler with respect to Claims 1 and 19. Milani does not provide the missing teachings.

Second, Milani does not teach that charging an absorbent layer provides improved liquid distribution. Milani teaches that improved liquid distribution may be provided in a fibrous article or web by introducing absorbent particles into the web. It is the combination of the fibers or web and the particles attached thereto that has improved liquid distribution. Hence, the issue is whether or not one would be led to replace the absorbent layer in Glaug with an absorbent layer according to Milani, and whether that new layer would be electrostatically charged. Merely charging the absorbent layer of Glaug does not provide the benefit to which the Examiner points.

Milani teaches a method of introducing particles in which an article comprising loose fibers or a web is modified to include absorbent particles. The article is charged to a first charge and the particles are charged to the opposite charge so as to cause the particles to be coupled to the article when the particles are introduced into the article. There is no teaching in Milani that the modified article obtained by introducing particles into the fibers or web is electrostatically charged after the introduction of the particles. In this regard, it should be noted that even if the underlying fibers or web are permanently charged, that charge would be cancelled by the oppositely charged particles that are coupled to the fibers or web. The Examiner has not pointed to any teaching indicating that the final composition is electrostatically charged.

Furthermore, the Examiner has not pointed to any teaching that the invention of Glaug with the absorbent layer of Milani would be likely to have better liquid distribution than the absorbent layer taught in Glaug. Accordingly, Applicant submits that there are additional grounds for allowing Claims 4 and 22.

F. Rejection of Claims 6 and 24 under 35 U.S.C. 103(a) as being unpatentable over Glaug in view of Hassenboehler and further in view of Chen and further in view of Milani

The Examiner stated that the combination of Glaug, Hassenboehler and Chen is applied as in the case of the rejection of Claims 1 and 19. The Examiner admits that the combination does not teach an electrostatically charged fibrous mat. The Examiner looks to Milani for the teaching of charging a fibrous mat. The Examiner maintains that it would be obvious to charge the mat of Chen because Milani teaches that this would lead to better liquid distribution.

First, Applicant wishes to point out that the combination of Glaug, Hassenboehler, and Chen was applied in the rejection of Claims 5 and 23 from which the claims at issue depend, not Claims 1 and 19. Applicant repeats these arguments here. As noted above, this combination does not provide a *prima facie* case for obviousness with respect to the Claims 5 and 23. Milani does not provide the missing teachings or suggestions.

Second, as pointed out above, Milani does not teach that electrostatically charging a mat leads to improved liquid distribution. Milani teaches that improved absorbency can be obtained by utilizing a method in which absorbent particles are inserted into a fibrous mat by electrostatically charging the mat and particles.

Third, the Examiner's argument assumes that the fibrous web of Chen can be electrostatically charged and hold that charge. The Examiner has not pointed to any teaching to support this assumption. In this regard, it should be noted that not all fibrous webs can be charged. Accordingly, Applicant submits that there are additional grounds for allowing Claims 6 and 24.

VIII. CONCLUSION

Applicant respectfully submits that for the reasons of fact and law argued herein, the decision of the Examiner in finally rejecting Claims 1-8 and 19-28 should be reversed.

I hereby certify that this paper (along with any others attached hereto) is being sent via facsimile to fax number: 571-273-8300

Respectfully Submitted,



Calvin B. Ward
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APPENDIX**THE CLAIMS ON APPEAL:**

1. A protective covering comprising:

a water-impermeable electrostatically charged sheet having a top and bottom surface; and

an absorbent layer having top and bottom surfaces, said bottom surface of said absorbent layer being bonded to said top surface of said electrostatically charged sheet, said absorbent layer being divided into a plurality of cells for containing liquid within the boundaries of said cells, said liquid being prevented from moving between said cells.
2. The protective covering of Claim 1, wherein said absorbent layer comprises paper.
3. The protective covering of Claim 1, wherein said absorbent layer comprises an open cell foam.
4. The protective covering of Claim 3, wherein said foam is electrostatically charged.
5. The protective covering of Claim 1, wherein said absorbent layer comprises a fibrous mat.
6. The protective covering of Claim 5, wherein said fibrous mat is electrostatically charged.
7. The protective covering of Claim 1, wherein said absorbent layer comprises a plurality of hydrophobic barriers, said hydrophobic barriers defining said cells.

8. The protective covering of Claim 1 further comprising a hydrophobic layer bonded to said top surface of said absorbent layer, said hydrophobic layer having a plurality of pores therethrough, said pores allowing liquid to penetrate said hydrophobic layer and be absorbed by said absorbent layer.

19. A protective covering for protecting an exposed surface:

a water-impermeable electrostatically charged sheet having a top and bottom surface; and
an absorbent layer having top and bottom surfaces, said bottom surface of said absorbent layer being in contact with said top surface of said electrostatically charged sheet.

20. The protective covering of Claim 19, wherein said absorbent layer comprises paper.

21. The protective covering of Claim 19, wherein said absorbent layer comprises an open cell foam.

22. The protective covering of Claim 21, wherein said foam is electrostatically charged.

23. The protective covering of Claim 19, wherein said absorbent layer comprises a fibrous mat.

24. The protective covering of Claim 23, wherein said fibrous mat is electrostatically charged.

25. The protective covering of Claim 19, wherein said absorbent layer comprises a plurality of hydrophobic barriers, said hydrophobic barriers defining a plurality of cells for containing liquid within the boundaries of said cells, said liquid being prevented from moving between said cells by said barriers.

26. The protective covering of Claim 19 wherein said absorbent layer further comprises a hydrophobic layer bonded to said top surface of said absorbent layer, said hydrophobic layer having a plurality of pores therethrough, said pores allowing liquid to penetrate said hydrophobic layer and be absorbed by said absorbent layer.

27. The protective covering of Claim 19 wherein said electrostatically charged layer is bonded to said absorbent layer.

28. The protective covering of Claim 19 wherein said absorbent layer is divided into a plurality of cells for containing liquid by liquid impermeable barriers that prevent liquid from moving from one cell to another.

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Second, the canals taught in Glaug are open ended. Hence, while the barriers prevent liquid from moving from one canal to another along the length of the canal, the barriers do not contain the liquid within the boundaries of the cells, since the ends of the cells are open. In fact, in the embodiments taught in Glaug, the boundaries allow liquid to flow between chambers when one chamber becomes full. Hence, there are additional grounds for allowing Claim 1.

With respect to Claims 2 and 20, the Examiner maintains that Glaug teaches the absorbent layer comprises paper or polymeric foam. The Examiner points to the passage at (col. 2, lines 60-65 – col. 3, line 5) as supporting this contention. The passage from col. 2, line 60 to col. 3, line 2 refers to the barriers as comprising the polymeric foam. Glaug also teaches that

barriers can be constructed from water proof paper. The remainder of the cited passage refers to the absorbent layer being chosen from a list of materials that does not include paper. Hence, there are additional grounds for allowing Claims 2 and 20.

With respect to Claims 3 and 21, the Examiner looks to the passage of Glaug at col. 4, lines 14-15 as teaching that the absorbent layer comprises an open cell foam, Applicant must disagree with the Examiner's reading of the passage in question. The passage refers to material for constructing the barriers, not the absorbent layer. Hence, there are additional grounds for allowing Claims 3 and 21.

D. Rejection of Claims 5 and 23 under 35 U.S.C. 103(a) as being unpatentable over Glaug in view of Hassenboehler and further in view of Chen

In making this rejection, the Examiner looks to the combination of Glaug and Hassenboehler as teaching the limitations of Claims 1 and 19. The Examiner admits that these references do not teach an absorbent material comprising a fibrous mat. The Examiner looks to Chen as teaching a fibrous mat.

Applicant repeats the arguments made above with respect to the missing teachings of the Glaug and Hassenboehler as applied to Claims 1 and 19. Chen does not provide the missing teachings. Accordingly, Applicant submits that the Examiner has not made a *prima facie* case for obviousness with respect Claims 5 and 23.

E. Rejection of Claims 4 and 22 under 35 U.S.C. 103(a) as being unpatentable over Glaug in view of Hassenboehler and further in view Milani

The Examiner looks to Glaug and Hassenboehler as teaching the elements of Claims 1 and 19. The Examiner admits that the combined references do not teach an absorbent layer that is an electrostatically charged open cell foam. The Examiner looks to Milani as providing the missing teaching. The Examiner maintains that it would be obvious to combine the teachings of Milani with the other references because Milani teaches that the charging provides improved liquid distribution.

First, Applicant repeats the arguments made above with respect to the lack of teachings of Glaug and Hassenboehler with respect to Claims 1 and 19. Milani does not provide the missing teachings.

Second, Milani does not teach that charging an absorbent layer provides improved liquid distribution. Milani teaches that improved liquid distribution may be provided in a fibrous article or web by introducing absorbent particles into the web. It is the combination of the fibers or web and the particles attached thereto that has improved liquid distribution. Hence, the issue is whether or not one would be led to replace the absorbent layer in Glaug with an absorbent layer according to Milani, and whether that new layer would be electrostatically charged. Merely charging the absorbent layer of Glaug does not provide the benefit to which the Examiner points.

Milani teaches a method of introducing particles in which an article comprising loose fibers or a web is modified to include absorbent particles. The article is charged to a first charge and the particles are charged to the opposite charge so as to cause the particles to be coupled to the article when the particles are introduced into the article. There is no teaching in Milani that the modified article obtained by introducing particles into the fibers or web is electrostatically charged after the introduction of the particles. In this regard, it should be noted that even if the underlying fibers or web are permanently charged, that charge would be cancelled by the oppositely charged particles that are coupled to the fibers or web. The Examiner has not pointed to any teaching indicating that the final composition is electrostatically charged.

Furthermore, the Examiner has not pointed to any teaching that the invention of Glaug with the absorbent layer of Milani would be likely to have better liquid distribution than the absorbent layer taught in Glaug. Accordingly, Applicant submits that there are additional grounds for allowing Claims 4 and 22.

F. Rejection of Claims 6 and 24 under 35 U.S.C. 103(a) as being unpatentable over Glaug in view of Hassenboehler and further in view of Chen and further in view of Milani

The Examiner stated that the combination of Glaug, Hassenboehler and Chen is applied as in the case of the rejection of Claims 1 and 19. The Examiner admits that the combination does not teach an electrostatically charged fibrous mat. The Examiner looks to Milani for the teaching of charging a fibrous mat. The Examiner maintains that it would be obvious to charge the mat of Chen because Milani teaches that this would lead to better liquid distribution.

First, Applicant wishes to point out that the combination of Glaug, Hassenboehler, and Chen was applied in the rejection of Claims 5 and 23 from which the claims at issue depend, not Claims 1 and 19. Applicant repeats these arguments here. As noted above, this combination does not provide a *prima facie* case for obviousness with respect to the Claims 5 and 23. Milani does not provide the missing teachings or suggestions.

Second, as pointed out above, Milani does not teach that electrostatically charging a mat leads to improved liquid distribution. Milani teaches that improved absorbency can be obtained by utilizing a method in which absorbent particles are inserted into a fibrous mat by electrostatically charging the mat and particles.

Third, the Examiner's argument assumes that the fibrous web of Chen can be electrostatically charged and hold that charge. The Examiner has not pointed to any teaching to support this assumption. In this regard, it should be noted that not all fibrous webs can be charged. Accordingly, Applicant submits that there are additional grounds for allowing Claims 6 and 24.

VIII. CONCLUSION

Applicant respectfully submits that for the reasons of fact and law argued herein, the decision of the Examiner in finally rejecting Claims 1-8 and 19-28 should be reversed.

I hereby certify that this paper (along with any others attached hereto) is being sent via facsimile to fax number: 571-273-8300

Respectfully Submitted,



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APPENDIX

THE CLAIMS ON APPEAL:

1. A protective covering comprising:

a water-impermeable electrostatically charged sheet having a top and bottom surface; and

an absorbent layer having top and bottom surfaces, said bottom surface of said absorbent layer being bonded to said top surface of said electrostatically charged sheet, said absorbent layer being divided into a plurality of cells for containing liquid within the boundaries of said cells, said liquid being prevented from moving between said cells.
2. The protective covering of Claim 1, wherein said absorbent layer comprises paper.
3. The protective covering of Claim 1, wherein said absorbent layer comprises an open cell foam.
4. The protective covering of Claim 3, wherein said foam is electrostatically charged.
5. The protective covering of Claim 1, wherein said absorbent layer comprises a fibrous mat.
6. The protective covering of Claim 5, wherein said fibrous mat is electrostatically charged.
7. The protective covering of Claim 1, wherein said absorbent layer comprises a plurality of hydrophobic barriers, said hydrophobic barriers defining said cells.

8. The protective covering of Claim 1 further comprising a hydrophobic layer bonded to said top surface of said absorbent layer, said hydrophobic layer having a plurality of pores therethrough, said pores allowing liquid to penetrate said hydrophobic layer and be absorbed by said absorbent layer.

19. A protective covering for protecting an exposed surface:

a water-impermeable electrostatically charged sheet having a top and bottom surface; and

an absorbent layer having top and bottom surfaces, said bottom surface of said absorbent layer being in contact with said top surface of said electrostatically charged sheet.

20. The protective covering of Claim 19, wherein said absorbent layer comprises paper.

21. The protective covering of Claim 19, wherein said absorbent layer comprises an open cell foam.

22. The protective covering of Claim 21, wherein said foam is electrostatically charged.

23. The protective covering of Claim 19, wherein said absorbent layer comprises a fibrous mat.

24. The protective covering of Claim 23, wherein said fibrous mat is electrostatically charged.

25. The protective covering of Claim 19, wherein said absorbent layer comprises a plurality of hydrophobic barriers, said hydrophobic barriers defining a plurality of cells for containing liquid within the boundaries of said cells, said liquid being prevented from moving between said cells by said barriers.

26. The protective covering of Claim 19 wherein said absorbent layer further comprises a hydrophobic layer bonded to said top surface of said absorbent layer, said hydrophobic layer having a plurality of pores therethrough, said pores allowing liquid to penetrate said hydrophobic layer and be absorbed by said absorbent layer.

27. The protective covering of Claim 19 wherein said electrostatically charged layer is bonded to said absorbent layer.

28. The protective covering of Claim 19 wherein said absorbent layer is divided into a plurality of cells for containing liquid by liquid impermeable barriers that prevent liquid from moving from one cell to another.

PATENT APPLICATION

Attorney Docket: 54391

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS

Applicant:	Ward
Serial No.:	9/655,987
Filed:	9/6/2000
For:	Composition for Protecting Work Surfaces from Contamination
Group Art Unit:	1774
Examiner:	Dicus, Tamra

SUPPLEMENTAL BRIEF FOR APPELLANT

Hon. Commissioner of Patents
and Trademarks
Washington, D.C. 20231

Sir:

This is an appeal from the decision of the Primary Examiner dated 5/31/2005, rejecting Claims 1-8 and 19-28 in the above-identified patent application. Applicant originally filed an appeal after a final rejection dated 6/2/03. This first appeal was terminated by the Examiner because the Examiner wished to make new grounds for rejection. In addition to the new art rejection, the Examiner made a Section 112, second paragraph rejection that the Examiner could have made in the office action that preceded the first appeal. Because of this untimely new rejection, Applicant was forced to abandon the first appeal to correct this Section 112 issue. Were it not for that late Section 112 rejection, Applicant would have re-instated the original appeal, thereby saving the fees in question. Applicant filed a second appeal on 8/5/04 appealing the new grounds for rejection. The Examiner pointed out an error in the brief in question, and Applicant filed a corrected brief on 10/14/04. The Examiner then rejected the corrected brief because the Examiner maintained that the previously filed brief was defective because the summary of the invention did not contain a concise statement explanation of the subject matter of

each independent claim on appeal and because the grouping of the claims lacked a statement that each group of claims "stand or fall together". Applicant filed another brief pointing out that the Examiner was in error with respect to the "stand or fall together rejection" and that the Summary of the Invention had not changed since the original brief had been filed and that it met the requirements as proved by insertions indicating which independent claims were discussed at each point in the Summary.

The Examiner then re-opened prosecution again to make new grounds for rejection. This brief is filed to address the new grounds for rejection. To facilitate the Board's review of this matter, Applicant has repeated the information that does not pertain to the new grounds in this brief, but was provided in the previously filed briefs. It is assumed that the Examiner has now withdrawn all previous grounds for rejection. However, all previously filed briefs in this application are hereby incorporated by reference and relied upon to address the earlier grounds for rejection and to provide any missing required information that may be missing from this brief.

I. REAL PARTY IN INTEREST

The real party in interest is Calvin B. Ward.

II. RELATED APPEALS AND INTERFERENCES

There is an appeal in divisional application 10/278,190 presently pending that might directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. STATUS OF THE CLAIMS

Claims 1-8 and 19-28 are currently pending in the above-identified patent application. In the Office Action dated 5/31/2005, the Examiner reopened prosecution and rejected these claims.

IV. STATUS OF AMENDMENTS

No amendments have been entered after the rejection discussed above,

V. SUMMARY OF THE INVENTION

The present invention is directed to using a novel sheet to protect a surface by placing this sheet in contact with the surface. Refer to Figure 1 and the discussion thereof that begins at line 4 of page 3 of the specification. With reference to Claims 1 and 19, sheet 10 is constructed from an electrostatically charged sheet 11 having a top and bottom surface and an absorbent layer 12. The absorbent layer has top and bottom surfaces, the bottom surface of the absorbent layer being bonded to the top surface of the electrostatically charged sheet. With reference to Claim 19, the absorbent layer is divided into a plurality of cells 14 for containing liquid spilled on the absorbent layer. The absorbent layer can be constructed from paper, open cell foam, a fibrous mat, or any other absorbent material. In one preferred embodiment, the cells are constructed by providing hydrophobic barriers 13 in the absorbent layer. The barriers can be constructed from paraffin, plastic, or any other material that can penetrate the absorbent layer. Referring to Figure 2, and the discussion thereof that begins at page 4, line 18, a hydrophobic layer 21 is bonded to the top surface of the absorbent layer. The hydrophobic layer has a plurality of pores 22 that allow liquid spilled on the hydrophobic layer to penetrate the hydrophobic layer and be absorbed by the absorbent layer.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

A. Rejection of Claims 19-20 under 35 U.S.C. 102(b) as being anticipated by Schelhorn, *et al* (hereafter "Schelhorn") (US 3,342,613)

B. Rejection of Claims 1-3, 7-8, 19-21, and 25-28 under 35 U.S.C. 103(a) as being unpatentable over US 5,151,091 to Glaug, *et al* (hereafter "Glaug") in view of US 5,486,411 to Hassenboehler Jr., *et al* (hereafter "Hassenboehler").

C. Rejection of Claims 5 and 23 under 35 U.S.C. 103(a) as being unpatentable over Glaug in view of Hassenboehler and further in view of US 6,261,679 to Chen, *et al* (hereafter "Chen").

D. Rejection of Claims 4 and 22 under 35 U.S.C. 103(a) as being unpatentable over Glaug in view of Hassenboehler and further in view of US 5,807,366 to Milani.

E. Rejection of Claims 6 and 24 under 35 U.S.C. 103(a) as being unpatentable over Glaug in view of Hassenboehler and further in view of Chen and further in view of Milani.

VII. ARGUMENT

A. Examiner's Burden under 35 U.S.C. 102 and 103

Under 34 U.S.C. 102, the Examiner has the burden of showing by reference to the cited art each claim limitation in the reference. Anticipation under 35 U.S.C. 102 requires that each element of the claim in issue be found either expressly or inherently in a single prior art reference. *In re King*, 231 USPQ 136, 138 (Fed. Cir. 1986); *Kalman v. Kimberly-Clark Corp.*, 218 USPQ 781, 789 (Fed. Cir. 1983). The mere fact that a certain thing may result from a given set of circumstances is not sufficient to sustain a rejection for anticipation. *Ex parte Skinner*, 2 USPQ2d 1788, 1789 (BdPatApp&Int 1986). "When the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference" (*In re Rijckaert*, 28 USPQ2d, 1955, 1957). Under the doctrine of inherency, if an element is not expressly disclosed in a prior art reference, the reference will still be deemed to anticipate a subsequent claim if the missing element "is necessarily present in the thing described in the reference." *Cont'l Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). "Inherent anticipation requires that the missing descriptive material is 'necessarily present,' not merely probably or possibly present, in the prior art." *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295, 63 USPQ2d 1597, 1599 (Fed. Cir. 2002) (quoting *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)).

To sustain a rejection under 35 U.S.C. 103, the Examiner must show that the combined references teach each of the elements of the claim or that there is some motivation in the art for altering one of the teachings to arrive at the combined set of teachings. "The mere fact that a reference could be modified to produce the patented invention would not make the modification obvious unless it is suggested by the prior art." (*Libbey-Owens-Ford v. BOC Group*, 4 USPQ 2d 1097, 1103). "When the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference" (*In re*

Rijckaert, 28 USPQ2d, 1955, 1957). In addition, the Examiner must show that there is some motivation in the art that would cause someone of ordinary skill to combine the references, and that in making the combination, there was a reasonable expectation of success. Where the claimed subject matter has been rejected as obvious in view of a combination of prior art references, a proper analysis under section 103 requires, *inter alia*, consideration of two factors: (1) whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed composition or device, or carry out the claimed process; and (2) whether the prior art would also have revealed that in so making or carrying out, those of ordinary skill would have a reasonable expectation of success. Both the suggestion and the reasonable expectation of success must be founded in the prior art, not in the applicant's disclosure. *In re Vaack*, 20 USPQ2d 1438, 1442(CAFC 1991).

B. Rejection of Claims 19-20 under 35 U.S.C. 102(b) as being anticipated by Schelhorn

In making this rejection, the Examiner looks to Figure 2 of Schelhorn, and specifically to element 10 as the water-impermeable electrostatically charged sheet required by Claim 19. However the Examiner has not pointed to any teaching that sheet 10 is electrostatically charged. Schelhorn teaches that the sheet is electrostatically treated or flame treated to improve the adhesive bonding characteristics of that surface (col. 2, lines 21-29), i.e., to cause the adhesive 14 to stick to the plastic sheet. Such treatments expose the surface of the sheet to a plasma that etches the surface. There is no teaching that the plastic sheet is left with an electrostatic charge after such treatment, no less that the electrostatic charge remains after it is placed in contact with the absorbent layer. It should be noted that plastic sheets can be temporarily charged by a number of methods; however, the charge rapidly dissipates on contact with the air or other materials. Further, such corona treatments are used commercially to remove static charge from sheets of plastic. Hence, merely subjecting plastic to an electrostatic treatment does not necessarily lead to an electrostatically charged sheet that has a charge that remains on the sheet at the end of the treatment. Accordingly, Schelhorn does not anticipate the present invention as claimed in Claim 19 either explicitly or inherently.

C. Rejection of Claims 1-3, 7-8, 19-21, and 25-28 under 35 U.S.C. 103(a) as being unpatentable over US 5,151,091 to Glaug in view of US 5,486,411 to Hassenboehler

With reference to Claims 1 and 19, the Examiner points to element 190 shown in Figure 2 of Glaug as the water-impermeable sheet and to the "canals" as the absorbent sheet that is divided into a plurality of cells. The Examiner admits that Glaug does not teach that sheet 190 is electrostatically charged. The Examiner looks to Hassenboehler as teaching that a polyethylene film can be electrostatically treated to improve filtration. The Examiner maintains that it would be obvious to apply the teachings of Hassenboehler to sheet 190 to improve filtration.

First, Applicant must point out that Hassenboehler teaches electrostatically charging a porous film to provide improved filtration of a medium passing through the film. A porous film is not water-impermeable. Sheet 190 taught in Glaug must be water impermeable to provide the desired barrier function. Furthermore, it does not provide any filtration function. Hence, one would not be led to apply the teachings of Hassenboehler to the article in Glaug because the article would either fail at its intended purpose, i.e., leak through the pores, or because there is no filtration function to improve with respect to sheet 190, and hence, there is no motivation to apply the teachings. Accordingly, Applicant submits that the Examiner has not made a *prima facie* case for obviousness with respect to Claims 1 and 19 or the claims dependent therefrom.

Second, the canals taught in Glaug are open ended. Hence, while the barriers prevent liquid from moving from one canal to another along the length of the canal, the barriers do not contain the liquid within the boundaries of the cells, since the ends of the cells are open. In fact, in the embodiments taught in Glaug, the boundaries allow liquid to flow between chambers when one chamber becomes full. Hence, there are additional grounds for allowing Claim 1.

With respect to Claims 2 and 20, the Examiner maintains that Glaug teaches the absorbent layer comprises paper or polymeric foam. The Examiner points to the passage at (col. 2, lines 60-65 – col. 3, line 5) as supporting this contention. The passage from col. 2, line 60 to col. 3, line 2 refers to the barriers as comprising the polymeric foam. Glaug also teaches that

barriers can be constructed from water proof paper. The remainder of the cited passage refers to the absorbent layer being chosen from a list of materials that does not include paper. Hence, there are additional grounds for allowing Claims 2 and 20.

With respect to Claims 3 and 21, the Examiner looks to the passage of Glaug at col. 4, lines 14-15 as teaching that the absorbent layer comprises an open cell foam, Applicant must disagree with the Examiner's reading of the passage in question. The passage refers to material for constructing the barriers, not the absorbent layer. Hence, there are additional grounds for allowing Claims 3 and 21.

D. Rejection of Claims 5 and 23 under 35 U.S.C. 103(a) as being unpatentable over Glaug in view of Hassenboehler and further in view of Chen

In making this rejection, the Examiner looks to the combination of Glaug and Hassenboehler as teaching the limitations of Claims 1 and 19. The Examiner admits that these references do not teach an absorbent material comprising a fibrous mat. The Examiner looks to Chen as teaching a fibrous mat.

Applicant repeats the arguments made above with respect to the missing teachings of the Glaug and Hassenboehler as applied to Claims 1 and 19. Chen does not provide the missing teachings. Accordingly, Applicant submits that the Examiner has not made a *prima facie* case for obviousness with respect Claims 5 and 23.

E. Rejection of Claims 4 and 22 under 35 U.S.C. 103(a) as being unpatentable over Glaug in view of Hassenboehler and further in view Milani

The Examiner looks to Glaug and Hassenboehler as teaching the elements of Claims 1 and 19. The Examiner admits that the combined references do not teach an absorbent layer that is an electrostatically charged open cell foam. The Examiner looks to Milani as providing the missing teaching. The Examiner maintains that it would be obvious to combine the teachings of Milani with the other references because Milani teaches that the charging provides improved liquid distribution.

First, Applicant repeats the arguments made above with respect to the lack of teachings of Glaug and Hassenboehler with respect to Claims 1 and 19. Milani does not provide the missing teachings.

Second, Milani does not teach that charging an absorbent layer provides improved liquid distribution. Milani teaches that improved liquid distribution may be provided in a fibrous article or web by introducing absorbent particles into the web. It is the combination of the fibers or web and the particles attached thereto that has improved liquid distribution. Hence, the issue is whether or not one would be led to replace the absorbent layer in Glaug with an absorbent layer according to Milani, and whether that new layer would be electrostatically charged. Merely charging the absorbent layer of Glaug does not provide the benefit to which the Examiner points.

Milani teaches a method of introducing particles in which an article comprising loose fibers or a web is modified to include absorbent particles. The article is charged to a first charge and the particles are charged to the opposite charge so as to cause the particles to be coupled to the article when the particles are introduced into the article. There is no teaching in Milani that the modified article obtained by introducing particles into the fibers or web is electrostatically charged after the introduction of the particles. In this regard, it should be noted that even if the underlying fibers or web are permanently charged, that charge would be cancelled by the oppositely charged particles that are coupled to the fibers or web. The Examiner has not pointed to any teaching indicating that the final composition is electrostatically charged.

Furthermore, the Examiner has not pointed to any teaching that the invention of Glaug with the absorbent layer of Milani would be likely to have better liquid distribution than the absorbent layer taught in Glaug. Accordingly, Applicant submits that there are additional grounds for allowing Claims 4 and 22.

F. Rejection of Claims 6 and 24 under 35 U.S.C. 103(a) as being unpatentable over Glaug in view of Hassenboehler and further in view of Chen and further in view of Milani

The Examiner stated that the combination of Glaug, Hassenboehler and Chen is applied as in the case of the rejection of Claims 1 and 19. The Examiner admits that the combination does not teach an electrostatically charged fibrous mat. The Examiner looks to Milani for the teaching of charging a fibrous mat. The Examiner maintains that it would be obvious to charge the mat of Chen because Milani teaches that this would lead to better liquid distribution.

First, Applicant wishes to point out that the combination of Glaug, Hassenboehler, and Chen was applied in the rejection of Claims 5 and 23 from which the claims at issue depend, not Claims 1 and 19. Applicant repeats these arguments here. As noted above, this combination does not provide a *prima facie* case for obviousness with respect to the Claims 5 and 23. Milani does not provide the missing teachings or suggestions.

Second, as pointed out above, Milani does not teach that electrostatically charging a mat leads to improved liquid distribution. Milani teaches that improved absorbency can be obtained by utilizing a method in which absorbent particles are inserted into a fibrous mat by electrostatically charging the mat and particles.

Third, the Examiner's argument assumes that the fibrous web of Chen can be electrostatically charged and hold that charge. The Examiner has not pointed to any teaching to support this assumption. In this regard, it should be noted that not all fibrous webs can be charged. Accordingly, Applicant submits that there are additional grounds for allowing Claims 6 and 24.

VIII. CONCLUSION

Applicant respectfully submits that for the reasons of fact and law argued herein, the decision of the Examiner in finally rejecting Claims 1-8 and 19-28 should be reversed.

I hereby certify that this paper (along with any others attached hereto) is being sent via facsimile to fax number: 571-273-8300

Respectfully Submitted,



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APPENDIX**THE CLAIMS ON APPEAL:**

1. A protective covering comprising:

a water-impermeable electrostatically charged sheet having a top and bottom surface; and

an absorbent layer having top and bottom surfaces, said bottom surface of said absorbent layer being bonded to said top surface of said electrostatically charged sheet, said absorbent layer being divided into a plurality of cells for containing liquid within the boundaries of said cells, said liquid being prevented from moving between said cells.
2. The protective covering of Claim 1, wherein said absorbent layer comprises paper.
3. The protective covering of Claim 1, wherein said absorbent layer comprises an open cell foam.
4. The protective covering of Claim 3, wherein said foam is electrostatically charged.
5. The protective covering of Claim 1, wherein said absorbent layer comprises a fibrous mat.
6. The protective covering of Claim 5, wherein said fibrous mat is electrostatically charged.
7. The protective covering of Claim 1, wherein said absorbent layer comprises a plurality of hydrophobic barriers, said hydrophobic barriers defining said cells.

8. The protective covering of Claim 1 further comprising a hydrophobic layer bonded to said top surface of said absorbent layer, said hydrophobic layer having a plurality of pores therethrough, said pores allowing liquid to penetrate said hydrophobic layer and be absorbed by said absorbent layer.

19. A protective covering for protecting an exposed surface:

a water-impermeable electrostatically charged sheet having a top and bottom surface; and

an absorbent layer having top and bottom surfaces, said bottom surface of said absorbent layer being in contact with said top surface of said electrostatically charged sheet.

20. The protective covering of Claim 19, wherein said absorbent layer comprises paper.

21. The protective covering of Claim 19, wherein said absorbent layer comprises an open cell foam.

22. The protective covering of Claim 21, wherein said foam is electrostatically charged.

23. The protective covering of Claim 19, wherein said absorbent layer comprises a fibrous mat.

24. The protective covering of Claim 23, wherein said fibrous mat is electrostatically charged.

25. The protective covering of Claim 19, wherein said absorbent layer comprises a plurality of hydrophobic barriers, said hydrophobic barriers defining a plurality of cells for containing liquid within the boundaries of said cells, said liquid being prevented from moving between said cells by said barriers.

26. The protective covering of Claim 19 wherein said absorbent layer further comprises a hydrophobic layer bonded to said top surface of said absorbent layer, said hydrophobic layer having a plurality of pores therethrough, said pores allowing liquid to penetrate said hydrophobic layer and be absorbed by said absorbent layer.

27. The protective covering of Claim 19 wherein said electrostatically charged layer is bonded to said absorbent layer.

28. The protective covering of Claim 19 wherein said absorbent layer is divided into a plurality of cells for containing liquid by liquid impermeable barriers that prevent liquid from moving from one cell to another.